

03-02-05 #21 DP-C (F)
CASE 4-31336P1

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EV 336718851 US

Express Mail Label Number

March 1, 2004

Date of Deposit



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

MAR 04 2004

OFFICE OF PETITIONS

IN RE APPLICATION OF

Art Unit: 1644

CROWL ET AL.

Examiner: P. Nolan

APPLICATION NO: 09/522,699

FILED: MARCH 10, 2000

FOR: ARTHRITIS-ASSOCIATED PROTEIN

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW A HOLDING OF ABANDONMENT

Sir:

The above-identified application became abandoned for failure to respond to the Notice of Allowance and Issue Fee due with the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Notice of Allowance and Fee(s) due plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR WITHDRAWAL OF THE HOLDING OF ABANDONMENT OF THIS APPLICATION.

1. Petition Fee:

The Commissioner is hereby authorized to charge the \$130 fee under 37 CFR §1.17(h) and any additional fees that may be required to Deposit Account No. 19-0134 in the name of Novartis Corporation. An additional Copy of this paper is enclosed.

2. Reply and/or fee

a. The reply and/or fee to the Notice of Allowance in the form of an Issue Fee(s) transmittal is enclosed herewith.

b. The Issue fee of \$1300 is authorized in the fee transmittal which is enclosed herewith.

03/03/2004 AWONDAF1 00000093 190134 09522699

01 FC:1460 130.00 DA

RECEIVED

MAR 08 2004

TECH CENTER 1600/2900

c. As demonstrated by the Docket report submitted herewith, the Notice of Allowance and Issue Fee Due mailed on September 4, 2003 was not received by applicants' representative.

d. A Change of Correspondence Address application [form PTO/SB/122] is enclosed herewith.

3. Statement establishing non-receipt of Notice of Allowance

Applicants representative did not pay the required issue fee within the statutory period of 3 months from the mailing date of the Notice of Allowance. After receiving a Notice of Abandonment, the case file was reviewed and it was found that prior to receiving the Notice of Abandonment, no action from the examiner had been received since the last correspondence on behalf of applicants dated January 3, 2003. After contacting the USPTO, applicants' representative was informed that the Notice of Allowance was mailed on September 4, 2003. The Notice of Allowance was never received by applicants' representative or any members of the Corporate Intellectual Property Department, including the docketing staff. A search of the file jacket and docket records indicates that the Notice of Allowance was not received. A printout of the docket report showing all replies that were docketed for response on December 4, 2003 is submitted herewith. The docket report does not include a docketing entry for payment of the issue fee for the above-identified application (Docket Reference # 4-31336P1). Accordingly, it is respectfully submitted that applicants' representative never received the Notice of Allowance.

In light of the above remarks and the docket report submitted herewith, it is respectfully requested that the holding of abandonment of the above-identified case be withdrawn, that the Issue Fee submitted herewith be accepted, and the case passed to issue.

Respectfully submitted,



David E. Wildman
Attorney for Applicants
Reg. No. 40,226

Novartis
Corporate Intellectual Property
One Health Plaza, Building 430
East Hanover, NJ 07936-1080
(862) 778-7954

Date: March 1, 2004

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE
 Commissioner for Patents
 Alexandria, Virginia 22313-1450
 or **Fax** (703) 746-4000

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections to use Block 1)
 7590 09/04/2003

Thomas Hoxie
 Novartis Corporation
 Patent and Trademark Dept
 564 Morris Avenue
 Summit, NJ 07901-1027

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission
 I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO, on the date indicated below.

(Depositor's name)

(Signature)

(Date)

MAR 04 2004

SEE FILING BY EXPRESS MAIL BELOW

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/522,699 | 03/10/2000 | Robert Mitchell Crowl | 4-31336P1 | 5894 |

TITLE OF INVENTION: ARTHRITIS-ASSOCIATED PROTEIN

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO | \$1300 | \$0 | \$1300 | 12/04/2003 |

| EXAMINER | ART UNIT | CLASS-SUBCLASS |
|------------------|----------|----------------|
| NOLAN, PATRICK J | 1644 | 536-023500 |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☒ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 David E. Wildman

2

3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Novartis AG

Basel, Switzerland

Please check the appropriate assignee category or categories (will not be printed on the patent); ☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

☒ Issue Fee☐ Publication Fee☒ Advance Order - # of Copies 10

4b. Payment of Fee(s):

☐ A check in the amount of the fee(s) is enclosed.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number 19-0134 (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature)

(Date)

3/1/04

David E. Wildman Registration # 40,226

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FILING BY "EXPRESS MAIL"
 UNDER 37 CFR 1.19

EV 336718851 US

Express Mail Label Number

march 1, 2004

Date of Deposit

03/03/2004 AWONDAF2 00000024 190134 09522699

01 FC:1501

1330.00 DA

03 FC:8001

30.00 DA

TRANSMIT THIS FORM WITH FEE(S)

PATENT USER ACTION REPORT BY DUPLICATE DATE

FROM: 12/4/2003
THROUGH: 12/4/2003
STATUS: ACTIVE

Printed: 2/27/2004 Page 1

| REFERENCE# | MARK/TITLE | COUNTRY | ACTION | ORIGINAL DUE DT | FINAL | RESPONSE | ATTY1 / ATTY2 PARA |
|----------------|------------------------------|---------|----------------------|--------------------|-----------|------------|-----------------------|
| 4-100-8241D | PHARMACEUTICAL COMPOSITIO | US | CK.FOR ISSUE NOTIF. | 12/04/2003 | 12/4/2003 | 7/18/2003 | EJW/N/A/N/A |
| 4-30476D | COMPOSITIONS AND THEIR USE | US | FILG RCPT CHK | 12/04/2003 | 12/4/2003 | 12/4/2003 | HJP/N/A/N/A |
| 4-30656A | METHOD FOR SCREENING COMP | US | RESPONSE TO OA (1MO) | 12/04/2003 | 5/4/2004 | 11/21/2003 | PLH/N/A/N/A |
| 4-31153A | PROCESS FOR PHENYLACETIC A | US | RESPONSE TO OA (1MO) | 12/04/2003 | 5/4/2004 | 12/1/2003 | DEW/N/A/N/A |
| 4-31320A | DIPEPTIDE NITRILE CATHEPSIN | US | REQ PATENT TERM ADJ | 12/04/2003 | 12/4/2003 | 12/23/2003 | DEW/N/A/N/A |
| 4-31440B | NOVEL GENE | US | RESPONSE TO OA (1MO) | 12/04/2003 | 5/4/2004 | 11/25/2003 | DGB/N/A/N/A |
| 4-31613A | DIAZACYCLOALKANEDIONE DERI | US | REQ PATENT TERM ADJ | 12/04/2003 | 12/4/2003 | 12/23/2003 | NG/N/A/N/A |
| 4-31912A | PHARMACEUTICAL COMPOSITIO | US | FILG RCPT CHK | 12/04/2003 | 12/4/2003 | 12/29/2003 | GRD/N/A/N/A |
| 4-31932A/32282 | FUSED PYRIDINE DERIVATIVES F | US | FILG RCPT CHK | 12/04/2003 | 6/4/2004 | | HJP/N/A/N/A |
| 4-31993A | OXAZOLO- AND FUOPYRIMIDIN | US | POST CARD CHECK | 12/04/2003 | 12/4/2003 | 11/14/2003 | DPT/N/A/N/A |
| 4-31994A | COMBINATION COMPRISING N-(5 | US | POST CARD CHECK | 12/04/2003 | 12/4/2003 | 11/14/2003 | DPT/N/A/N/A |
| 4-32316A | USE OF ORGANIC COMPOUNDS | US | RESPONSE TO OA | 12/04/2003 | 3/4/2004 | 11/7/2003 | GRD/N/A/N/A |
| 4-32410A | USE OF ORGANIC COMPOUNDS | US | RESPONSE TO OA | 12/04/2003 | 3/4/2004 | | DPT/N/A/N/A |
| 4-32644A | TREATMENT OF TUBEROUS SCL | US | FILG RCPT CHK | 12/04/2003 | 12/4/2003 | 11/24/2003 | GRD/N/A/N/A |
| IB/G-33138P1 | STABLE PHARMACEUTICAL COM | WO | POST CARD CHECK | 12/04/2003 | 3/4/2004 | 11/17/2003 | JDT/N/A/N/A |
| IB/G-33138P1 | STABLE PHARMACEUTICAL COM | WO | FILING CONFIRMATION | 12/04/2003 | 12/4/2003 | 12/3/2003 | JDT/N/A/N/A |
| N-32553A | NUTRITIONAL COMPOSITIONS | US | FILG RCPT CHK | 12/04/2003 | 12/4/2003 | 12/4/2003 | JWK/N/A/N/A |
| RG/G-31966A | PHARMACEUTICAL COMPOSITIO | US | POST CARD CHECK | 12/04/2003 | 12/4/2003 | 11/14/2003 | JDT/N/A/N/A |

END OF REPORT

TOTAL ITEMS SELECTED = 18